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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,845	05/23/2001	Herve F. Bouix	2870/296	9937

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EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,845

Applicant(s)

BOUIX ET AL.

Examiner

Tri M. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 13-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that the claimed container can not be made by other methods. This is not found persuasive because the patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe , 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Furthermore, there are other methods that the container as set forth can be made, e.g., the plastic coating can be sprayed on the container, similar to that of the Bailey reference(4129225).

With respect to the election of species, claim 11 is withdrawn from further consideration because Figs. 1-3 do not show one clearance exposing part of an outer surface of the bottle. This feature is shown in the embodiment of Fig. 7 as portion 75.

Furthermore, claim 13 is withdrawn further consideration because the embodiment of Fig. 1-3 does not show a second bottle.

Applicant traverses that the Office Action fails to show the claims have mutually exclusive characteristics. The election of species, as set forth in the previous Office Action, is based on multiple patentable species. In an election of species, the examiner not required to set forth reasons for holding of independence of distinctness. If applicant determines that the disclosed species are not patentably distinct, applicant must submit evidence and clearly admit on the record that is the case.

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Furthermore, the traversal is on the ground(s) that the independent claim 1 is the generic claim. This is not found persuasive because section 806.04(d) of the M.P.E.P defines a generic claim as follows:

In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species. see MPEP § 809.02(c)(2).

In this case, claim 1 contains a subcombination common to the claimed species.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name "Surlyn" cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4, 5, 7-9, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Barriere (3,663,259). Barriere teaches a container having a first thin-walled bottle with a neck 2 extending from a storage portion, and a minimum wall thickness, a resin body 5 having a maximum wall thickness at least three times the minimum wall thickness of the storage portion.

Regarding claim 2, the bottle is made from glass (col. 1, lines 51).

Regarding claim 5, the inside body is substantially round as claimed.

Regarding claims 9-10, note the indicia 3 being formed in the bottle. (col. 1, lines 30).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Frye et al. (4138027). Barriere meets all claimed limitations except for the inner bottle being made from aluminum. Frye teaches that it is known in the art to make the inner bottle out of aluminum (col. 2, line 64). It would have been obvious to one of ordinary skill in the art to

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make the inner bottle out of aluminum in Barriere as taught by Frye to provide the desired properties for the inner bottle.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Shaffer (3006780). Barriere meets all claimed limitations except for the resin body being square. Shaffer teaches that it is known in the art to provide an outer body being square. It would have been obvious to one of ordinary skill in the art to provide the resin body being square in Barriere as taught by Shaffer to provide added stability.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Richie (3738524). Barriere meets all claimed limitations except for the resin body is made from plastics under the trade name "Surlyn" (col. 7, lines 63). Richie teaches that it is known in the art to make a resin body from such plastic. It would have been obvious to one of ordinary skill in the art to make resin body is made from plastics under the trade name "Surlyn" in Barriere as taught by Richie to provide the desired properties.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barriere in view of Frye et al., as set forth above, and further in view of Reinhard (3870186). The modified container of Barriere meets all claimed limitations except for the inner bottle being anodized. Reinhard teaches that it is known in the art to anodize the inner surface of a body. It would have been obvious to one of ordinary skill in the art anodize the inner surface of the modified container of Barriere to provide the desired finish.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3579 for regular communications and (703)305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1148.

Tri M. Mai
Examiner
Art Unit 3727

T Mai

September 30, 2002